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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 05-364

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Signature _____

Typed or printed name _____

Application Number	Filed
10/537,365	June 2, 2005

First Named Inventor: Dieter Goldbach et al.

Art Unit	Examiner
3657	J. K. Hsiao

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 28,395.
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

/Gregory P. LaPointe #28395/
Signature

Gregory P. LaPointe
Typed or printed name

203 777 6628
Telephone number

January 7, 2009
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Applicants respectfully request the Examiner to reconsider his final rejection for the reasons set forth hereinbelow.

On Page 3 of the Examiner's Final Rejection, specifically the paragraph bridging pages 3 and 4, the Examiner sets forth the following:

> "Applicant's arguments with respect to claims 39-51 have been considered but they are not persuasive. Regarding the argument that the combination of the references would destroy the purpose of the primary reference, the rejection does not rely on the primary reference for the purpose of that reference. The rejection relies on the structure for purposes of examination.".

The Examiner's position is untenable and flies in the face of established case law. It is clearly established in the case law that references are not properly combinable or modifiable if their intended function is destroyed. "A §103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the *reference*, is not proper and the prima facie case of obviousness cannot be properly made. In short, there would be *no technological motivation* for engaging in the modification or change. To the contrary, there would be a disincentive. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The Federal Circuit observed in *Gordon* that if the prior art filter-separator were physically inverted, as would be necessary to meet claim limitation, the reference filter would become impenetrable and fluid would be trapped rather than separated."

The Examiner's position as set forth in his rejection and his response to Applicants' previously submitted arguments fly in the

face of the established case law set forth by The Federal Circuit. The Examiner's rejection is improper as the references cannot be properly combined in light of the fact that the modification as proposed by the Examiner would destroy the intended function of the primary reference.

In light of the foregoing, it is submitted that the Examiner should withdraw his rejection and issue a formal notice of allowance.